



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,239	12/11/2001	Amr F. Yassin	US010504	3135
24737 7590 07/19/2007 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			EXAMINER BOVEJA, NAMRATA	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 07/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/014,239

Applicant(s)

YASSIN ET AL.

Examiner

Namrata Boveja

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2001 and 01 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. This office action is in response to communication filed on 04/17/2007.
2. Claims 1-20 are presented for examination.
3. Amendments to claims 1-18 and newly added claims 19 and 20 have been entered and considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. *Claim 1-20 are rejected under U.S.C. 103(a) as being unpatentable over Robinson Publication Number US 2001/0054001 A1 (hereinafter Robinson) in view of Official Notice.*

In reference to claims 1, 11, and 18, Robinson teaches a method and system of presenting a commercial in a time slot to a viewer, the system and method comprising the acts of: providing one or more commercials to a receiver operatively coupled with a display device (page 8 paragraph 124), each commercial having an agent associated therewith (page 1 paragraph 9), the agent for each commercial configured to place a bid for the time slot on behalf of the associated commercial (page 1 paragraph 16), the bid including a reward component to be granted to the viewer if the associated commercial is selected (i.e. a user gets a reward for sharing information when an advertiser decides

Art Unit: 3622

to show a user a commercial based on how relevant the user is to the advertiser) (page 5 paragraphs 77-79); a profile database to store data related to local viewer preferences, including demographic information and viewing habit information, and allowing the agent for at least one commercial to access the local viewer preference related data in the profile database, the agent using the accessed local viewer preference related data to determine the bid to be placed for the time slot (page 1 paragraphs 5, 6, and 10 and page 6 paragraphs 89-91, and 94); and a processor capable of: auctioning the time slot to the one or more commercials provided to the receiver (page 1 paragraph 11 and page 3 paragraph 42); selecting the commercial having the agent which placed a winning bid and displaying the selected commercial on the display device during the time slot (page 3 paragraph 43); and storing information related to the commercial having the agent, which placed the winning bid in a vault (i.e. vault can refer to the receiver or user computer and it can refer to a remote server or servers where information can be stored in the arbitration module about the auctions) (page 2 paragraph 30, page 4 paragraphs 58 and 59 and page 6 paragraphs 92, 93, and 100).

Robinson does not teach the method wherein the wherein units of the reward component are selected by the viewer. Official Notice is taken that it is well known within the prior art for a user to select the units of the reward component as done by Hotel branded credit card companies who provide the users the option to select either airline miles, points towards free hotel night stays, or points that can be redeemed for gift cards, or even cash back for using their respective credit cards. Therefore, it would

have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Robinson's method the use of a user selected rewards to give the users a choice regarding the type of reward the user would like to earn instead of arbitrarily deciding a specific reward for the user that may or may not be the user's preference.

5. In reference to claims 2 and 12, Robinson teaches the method and system further comprising the act of: rewarding the viewer with the reward component of the winning bid (page 5 paragraphs 77-79).

6. In reference to claims 3 and 13, Robinson teaches the method and system further comprising the act of: storing information related to the commercial having the agent which placed the winning bid in a vault (page 2 paragraph 30 and page 6 paragraph 92).

7. In reference to claims 4 and 14, Robinson teaches the method and system further comprising the act of: allowing the agent for at least one commercial to access information previously stored in the vault, the agent using the accessed information to determine the bid to be placed for the time slot (i.e. in determining an appropriate bid amount, the agent has access to bidding results) (page 6 paragraphs 86 and 92).

8. In reference to claims 5 and 15, Robinson teaches the method and system further comprising the acts of: maintaining a profile database to store data related to local viewer preferences (page 1 paragraphs 5, 6, and 10 and page 6 paragraphs 89-91 and 94); and allowing the agent for at least one commercial to access the local viewer preference related data in the profile database, the agent using the accessed local

Art Unit: 3622

viewer preference related data to determine the bid to be placed for the time slot (page 1 paragraphs 5, 6, and 10 and page 6 paragraphs 89-91 and 94).

9. In reference to claims 6 and 16, Robinson teaches the method and system further comprising the *act* of the agent rewarding the viewer with the reward component of the winning bid (page 5 paragraphs 77-79).

Robinson does not teach the method and system wherein the local viewer preference related data maintained by the maintaining *act* identifies *the* units of the reward component, and the agent determines the units for the reward component of the bid to be placed based upon the viewer preference related data.

In reference to claims 6 and 16, Official Notice is taken that it is well known within the prior art for local user preference data to be maintained to identify the units of the reward component preferred by the user and for an agent to determine the units for the reward as done by Hotel branded credit card companies who provide the users the option to select either airline miles, points towards free hotel night stays, or points that can be redeemed for gift cards, or even cash back for using their respective credit cards and then store this information in the user's account for future transactions. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Robinson's method and system the use of local user preference data to be maintained to identify the units of the reward component preferred by the user and for an agent to determine the units for the reward to enable the users to select desired type of rewards instead of arbitrarily deciding a specific reward for the user that may or may not be the user's preference, and to prevent the user from

providing this information regarding his preference at the time of each transaction by making it available through the system.

10. In reference to claim 7, Robinson teaches the method wherein the bid placed by the agent of at least one commercial is a fixed amount (page 10 paragraph 15).

11. In reference to claim 8, Robinson teaches the method wherein the winning bid is chosen as the bid having the highest value in units preferred by the viewer (page 1 paragraph 15).

12. In reference to claim 9, Robinson teaches the use of the Vickrey auction, as well as other auction models (p. 5-6, paragraphs 83- 84). Robinson does not specifically disclose a method, wherein the winning bid awarded by the awarding step is determined by setting a desired monetary value, and then reducing the desired monetary value until the agent of at least one commercial places a bid at least equal to the desired monetary value. Official Notice is taken that it is well known within the prior art to use an auction in which an item is initially offered at a high price that is progressively lowered until a bid is made and the item sold also known as a Dutch auction as defined by Dictionary.com at <http://dictionary.reference.com/browse/dutch%20auction>. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Robinson's method the use of a Dutch auction to maximize the amount of revenues that can be obtained from the advertisers.

13. In reference to claim 10, Robinson teaches the method and system wherein the providing act includes loading at least one commercial and the agent associated

Art Unit: 3622

therewith onto the receiver prior to the time slot (page 3 paragraph 46 and page 8 paragraph 124).

14. In reference to claim 17, Robinson teaches the system further comprising: memory operatively coupled with the receiver, the source providing at least one commercial and the agent associated therewith onto the memory prior to the time slot (abstract, page 1 paragraph 9, page 8 paragraphs 124 and 125, and Figure 2).

15. *In reference to claims 19 and 20, Robinson does not teach the method and system, wherein the units include at least one of frequent flyer miles and calling minutes.*

Official Notice is taken that it is well known within the prior art for units of rewards to include of frequent flyer miles as offered by Hotel branded credit card companies rewards that provide the users the option to select either airline miles, points towards free hotel night stays, or points that can be redeemed for gift cards, or even cash back for using their respective credit cards. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Robinson's method and system units of rewards that include frequent flyer miles to give the users a choice regarding the type of reward the user would like to earn instead of arbitrarily deciding a specific reward for the user that may or may not be the user's preference.

Response to Arguments

16. After careful review of Applicant's remarks/arguments filed on 04/17/2007, the Applicant's arguments with respect to claims 1-18 and newly added claims 19 and 20

have been fully considered but are moot in view of the new ground(s) of rejection.

Amendments to claims 1-20 have been entered and considered.

17. The Applicant states that he does not concede any of the officially noticed facts in the prior action. With respect to this, the Examiner would like to point out that the Applicant has not presented arguments that the features are not well known. The Applicant's only argument has been, that he does not concede any officially noticed fact. This does not constitute a proper challenge to the Official Notice. Per the Applicant's citing of MPEP 2144.03, "A seasonable challenge constitutes a demand for evidence be made as soon as practicable during prosecution. Thus the applicant is charged with rebutting the well known statement in the next reply after the Office Action in which the well known statement was made." The Applicant has not submitted any rebuttal of the well known statements, but has merely stated that he does not concede to the officially noticed facts. In the paragraph in MPEP 2144.03 immediately preceding the above citing, reference is made to *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970) that "Furthermore, the applicant must be given the opportunity to challenge the correctness of such assertions and allegations." Again, the Applicant has not challenged the correctness of the assertions but rather only the use of Official Notice itself. Bald statements such as "And in particular, no Official Notices are conceded," are not adequate and do not shift the burden to the examiner to provide evidence in support of the Official Notice. Allowing such statements to challenge Official Notice would effectively destroy any incentive on part of the Examiner to use it in the process of establishing a rejection of notoriously well known facts (*In re Boon*, 169

USP 231 (CCPA 1971)).

18. Applicants additional remarks addressed to the new claim limitations have been addressed in the rejection necessitated by the amendments.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone

Art Unit: 3622


number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197.



NB

June 22nd, 2007


RETTA YEHDEGA
PRIMARY EXAMINER